

REMARKS

This Reply is in response to the Final Office Action mailed on December 29, 2006 in which claims 1-2, 5-15 and 21-27 were rejected. With this response, entry of amendments canceling claims 2, 5, 6, 21, 22 and 27 and amending claims 1 and 25 is requested. A terminal disclaimer is also enclosed. Because such amendments merely rewrite former dependent claims in independent form and because such amendments place the application in condition for allowance or at least in better form for appeal, entry of such amendments is believed to be proper. Claims 1, 7-15 and 23-26 are presented for reconsideration and allowance.

I. Rejection of Claim 7 Based upon Nonstatutory Obviousness-Type Double Patenting

Sections 2 and 3 of the Office Action rejected claims 7-15 and 23-24 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claim 23 of US Patent 6,666,594. Applicant respectfully notes that the Final Office Action fails to establish a prima facie case of nonstatutory obviousness-type double patenting with regard to claims 8-15 or claims 23-24. However, to move prosecution forward, a terminal disclaimer is filed to overcome the double patenting rejection based upon claim 23 of US Patent 6,666,594. Accordingly, the rejection of claim 7-15 and 23-24 on the grounds of non-statutory obviousness-type double patenting should be withdrawn.

II. Rejection of Claims 7, 8, 9, 21 and 26 under 35 USC 112, First Paragraph

Section 5 of the Office Action rejected claims 7, 8, 9, 21 and 26 under 35 USC 112, first paragraph as allegedly containing subject matter not described in the specification. In particular, the Office Action asserts:

The amendment and newly presented claims include the limitation (and its variations) of error messages "automatically conveyed over the network with a Web server in response to detection of the transmittal error". According, the specification at paragraphs [0028]-[0030], the errors conveyed after being detected. This is

not exactly the same as being "in response to detection". Applicant's amendment introduces "new matter" with the concept of "responsive to detection".

However, in contrast the assertion made in the Office Action, the specification does indeed provide support for the recitation that the error messages are "automatically conveyed over the network with a web server in response to detection of the ... error". In presenting such amendments, the previous response filed by Applicant pointed to Paragraphs [0028]-[0030] in context of Paragraph [0005]. Paragraph [0005] is found in the Background section of the present application and provide context for the rest of the application. Paragraph [0005] specifically states:

Errors that are relatively easy for a user to remedy may never be reported, even if they occur frequently. Even in-depth testing of individual printers may fail to show a pattern of errors that is common for that printer model, in actual use. The ability to automatically gather actual information on common printer errors for a large number of similar printers would constitute an improvement in the art.

(Emphasis added).

Paragraphs [0028] and [0029] describe a method wherein upon detection of errors, such errors are automatically conveyed. Paragraphs [0028] and [0029] recite:

[0028] If error detector 23 detects an error at any of the error detecting steps, an error message is generated as shown in box E4. The error message may be generated by the error detector 23, or by the web server 12. In some preferred embodiments, the error message is then written into an internal error log that is kept in the memory 22 of the printer 10.

[0029] Web server 12 then uses microprocessor 20 to convey the error message to an online error database 60. If necessary, web server 12 may be used to convert the error message into an appropriate format, such as an HTML file or an email message. Web server 12 then conveys the error message, in appropriate format, as one or more data packages (in accordance with a transfer protocol such as IP or TCP) to the network address of computer 42.

In an embodiment, such as that depicted in FIG. 3, this requires the data packets to be conveyed through network interface 16 and network 30, over the internet to I/O interface 46 of computer 42. Computer 42, which is preferably a network server, receives and assembles the data packet into the error message which is stored in the online database 60 in memory 52. Preferably, the reception and assembly is accomplished by microprocessor 50.

(Emphasis added).

Thus, Paragraphs [0028] and [0029] describe that if error detector 23 detects an error (Paragraph [0028]), then the error messages conveyed with a Web server (Paragraph [0029]. Nowhere do Paragraphs [0028] or [0029] describe or even mention any necessary intervening trigger or input before the error message is conveyed by the Web server. Unlike Bernklau-Halvor which is relied upon by the Office Action in rejecting the claims, Paragraphs [0028] and [0029] do not describe a process which requires the user to provide an input (a service request) before an error message is conveyed. Although Paragraphs [0028 and [0029] do not "exactly" use the term "automatically", one of ordinary skill in the art would clearly understand from such paragraphs that the error message is automatically conveyed in response to detection of the error.

Applicant further respectfully notes that the Office Action appears to take contradictory positions regarding what description satisfactorily supports the limitation of "automatically conveying error messages in response to detection of an error." In rejecting claim 7 on the ground of non-statutory business-type double patenting, the Office Action relies upon column 8, lines 20-25 of US Patent 6,666,594 and asserts that the "scope of 'conveying' in USPN 6,666,594 includes automatically conveying which is suggested by generation of e-mails conveying the error messages." (Final Office Action, page 7). However, column 8, lines 20-25 never "exactly" use the phrase "automatic" or that such conveyance would be "in response to detection of an error." Although column 7, lines 31-54 of US Patent 6,666,594 do describe a method wherein upon detection of an error, an error message is automatically written into a printer error archive 27, column 7, lines 31-54 also do not use the exact phrase "automatically in response to detection of an error." Rather, like Paragraphs [0028] and [0029] of the present

application, US Patent 6,666,594 also states that "if error detector 23 detects an error the error message is then written into the printer error archive 27." (Emphasis added). It is ironic that this "if A, then B" description in US Patent 6,666,594 means "automatic" for the purpose of rejecting the claims, yet substantially similar language in the present application (see Paragraph [0028] and [0029]) is not satisfactory for supporting the exact same claim limitation under 35 USC section 112. Accordingly, the rejection of claims 7, 8, 9, 21 and 26 under 35 USC 112, first paragraph is improper and should be withdrawn.

III. Rejection of Claim 27 under 35 USC 112, First Paragraph

Section 6 of the Office Action rejected claim 27 under 35 USC 112, first paragraph as allegedly containing subject matter not described in the specification. Claim 27 is canceled with its limitations incorporated into base claim 25. As noted below with respect to the rejection of claim 25, the limitations of former claim 27 find support in the originally filed specification.

IV. Rejection of Claims 1-6, 21-22 and 25-26 under 35 USC 102(e) Based upon Bernklau-Halvor

Sections 8-16 rejected claims 1-6, 21-22 and 25-26 under 35 USC 102(e) as being anticipated by Bernklau-Halvor US Patent 6,782,495. Applicant respectfully notes that Claims 3 and 4 were previously canceled. Claim 21 is canceled with its limitations incorporated into claim 1. Claims 2, 5, 6 and 22 are canceled. Claims 1, 25 and 26, as amended, overcome the rejection based upon Bernklau-Halvor.

A. Claim 1

Claims 1, as amended, recites a system for garnering information on printer errors. The system includes a plurality of printers each of the printers incorporating a Web server and an error detector for detecting errors in printing functions. The system further includes at least one receiving computer and at least one online error database capable of receiving an error message generated by any of the plurality of printers. Each printer is configured to automatically generate

and convey the error message over a network to the least one online error database upon detection of an error.

Bernklau-Halvor fails to disclose a system having an error database that receives error messages from multiple printers, wherein each printer is configured to automatically generate and convey the error message over a network to the least one online error database upon detection of an error. In contrast, Bernklau-Halvor only transmits the usage profile record after the user has specifically requested support for the printer. (See column 2, lines 21-65). Until such a request is made by the user, the usage profile information is that most stored in the printer itself. (See column 4, lines 46-50; column 5, line 16-18). Column 4, lines 50-55 specifically states:

when a request for service is made to the supply server 12, the support server will request any usage profile information stored about the printer to be sent to it for analysis. Alternatively, the printer may send the usage profile information with the request for support.

(Emphasis Added).

In response to such points raised by Applicant with regard to former claim 21, the limitations of which have now been incorporated into claim 1, Section 13 of the Office Action asserts:

Bernklau-Halvor taught the printer is configured to automatically generated and convey the error message over the network to the at least one online error database upon detection of an error (column 15, lines 27-31).

(Final Office Action, page 5).

However, this assertion is incorrect. Column 15, lines 27-31 of Bernklau-Halvor say nothing about automatically generating and conveying an error message over the network upon detection of an error. Column 15, lines 27-31 of Bernklau-Halvor states:

Usage Profile database 116 is used to store the Usage Profile information submitted from the user's printer. In addition to

PhaserSMART submitted to Usage Profile information, this database may also contain the Usage Profile information submitted via e-mail from printers.

Thus, relied upon portion of Bernklau-Halvor merely discloses how, not when, the Usage Profile information is submitted from the printer. As noted above, this information is submitted when a request for service is made by the user of the printer. Accordingly, claim 1, as amended, overcomes the rejection.

B. Claim 25

Claim 25 is amended to incorporate the limitations of former depending claim 27. Former dependent claim 27 was rejected based solely upon 35 USC 112, first paragraph. Section 6 of the Office Action rejected claim 27 under 35 USC 112, first paragraph as allegedly containing subject matter not described in the specification. In particular, the Office Action asserts that "Applicant's disclosure as originally filed does not divulge the concept of 'distinct' software programs. Inclusion of such a concept is new matter." (Final Office Action, page 4).

However, the assertion that the disclosure as originally filed does not divulge the concept of distinct software programs is incorrect. Paragraph [0032] of the present application specifically recites:

[0032] The error messages from a number of printers 10 may be all conveyed to the same network address, allowing the online database 60 to contain error messages from any number of printers. Alternatively, a number of different IP addresses may be used, allowing for a number of online databases to be maintained. It is preferred that if a number of different databases are kept, each database 60 will receive and contain information from a number of printers that are selected in various ways. This may be accomplished through the providing of each database 60 with separate IP addresses, among other possibilities. For example, only printers of a certain model may convey error messages to one database 60. Alternatively, only printers running certain software programs may send error information to a particular database 60.

A single printer 10 may send error information to one or more databases 60 at the same time.

(Emphasis added). Thus, Paragraph [0032] clearly supports the concept of multiple databases 60 which receive error messages from particular printers based upon the type of software programs running on such printers. Paragraph [0032] clearly supports printers running distinctive software programs, wherein there error messages from such printers having distinctive software programs are sent to different databases 60. One of ordinary skill in the art would clearly understand this from Paragraph [0032]. Accordingly, claim 25, as amended to incorporate the limitations of former claim 27, overcomes the rejection based upon Bernklau-Halvor. Claim 26 depends from claim 25 and overcomes rejection for the same reasons.

V. Conclusion

After amending the claims as set forth above, claims 1, 7-15 and 22-26 are now pending in this application.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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